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EXAMINER	
DENNISON, JERRY B	

ART UNIT	PAPER NUMBER
2143	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/715,641	HASKINS ET AL.	
	Examiner	Art Unit	
	J. Bret Dennison	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 June 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

RESPONSE TO AMENDMENT

1. This Action is in response to the Amendment for Application Number 09/715,641 received on 6/16/2006.

2. Claims 1-28 are presented for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tello et al. (U.S. Patent Number 6,381,634) in view of Janacek et al. (U.S. Patent Number 6,684,248).

1. Regarding claims 1, 2, 12-14, 15, and 26-28, Tello disclosed a system and method for controlling transmission of messages from an originator computer system, comprising:

a processor, memory system, and network interface (Tello, col. 3, line 60 through col. 4, line 5, The invention can be implemented with different computers, such as personal computers, UNIX based workstations, or devoted servers, having a communications protocol for Internet communication);

detecting an outbound message from an originator computer system (Tello, col. 6, lines 9-17, Tello disclosed the SCP counting the number of messages being sent by users);

verifying an authenticity of an originator address associated with the outbound message by comparing a mapping of network addresses with account names such that the originator is associated with a valid account name and network address pair (Tello, col. 5, lines 45-65, Tello disclosed password protected accounts for users to use their unique email addresses, meaning that users are verified before using their email address, therefore the originator address of every message sent out is verified. Tello also disclosed that the user's literal IP address is included in this authorization);

performing a quota enforcement operation based on a message count and a message limit to produce a message transmission result (Tello, col. 6, lines 9-17, Tello disclosed the SCP server detecting outbound messages from subscribed users, and performing a quota enforcement operation by comparing the number of messages sent by a user with a global threshold limit); and

performing a selective transmit operation including at least one of

i) transmitting the outbound message onto a computer network if the message transmission result contains a transmit value; and

ii) preventing transmission of the outbound message onto a computer network if the message transmission result contains a no transmit value (Tello, col. 6, lines 9-17, Tello disclosed if a user submits one-thousand messages, then

the global threshold limit is exceeded and the email messages do not get transmitted, otherwise they do get transmitted);

in order to determine a message transmission result that indicates if the originator computer system operating to transmit the outbound electronic mail message using the originator identity is attempting to transmit the outbound electronic mail message to a number of recipients that exceeds the message limit, and if the message transmission result is a no-transmit value, preventing transmission of outbound electronic mail messages onto the computer network for the originator identity, and if the message transmission result is a transmit value, allowing transmission of the outbound electronic mail message onto the computer network on behalf of the originator identity. (Tello, col. 5, lines 45-65, col. 6, lines 9-20, Tello discloses the SCP server detecting outbound messages from **subscribed users**, and performing a quota enforcement operation by comparing the number of messages sent by a user with a global threshold limit. If the message count exceeds the threshold limit, the messages do not get transmitted, and an error message is returned).

However, Tello did not explicitly state when the result is a transmit value, updating a message count associated with the originator identity of the outbound message.

It would have been obvious to one of ordinary skill in the art at the time the invention was made that keeping track of the number of messages and comparing against a global threshold limit would require updating a message count associated with the originator identity of the outbound message, in order to keep track of the number of

messages sent by one user, for the benefit of preventing spamming of unsolicited messages (Tello, col. 6, lines 1-17).

In an analogous art, Janacek disclosed a method of transferring data from a sender to a recipient including a server that contains a database that keeps track of user statistics, including a message count which tracks the total number of messages sent by the user (Janacek, col. 10, lines 55-67, col. 12, lines 1-5). Janacek also disclosed users having unique email addresses, that require user authentication in order to send and receive email with their unique email address (Janacek, col. 3, lines 50-67). Both Tello and Janacek include monitoring of subscriber usage of email systems. Therefore it would have been obvious to one in the ordinary skill in the art at the time of the invention to incorporate the user database of Janacek into Tello for the benefit of providing controlled message distribution (Janacek, col. 2, lines 50-55) while keeping secure message delivery as technically unchallenging as possible but still providing uncompromising data protection (col. 3, lines 30-35).

Claims 2, 12-14, 15, and 26-28 include limitations, substantially similar to claim 1, and are therefore rejected under the same rationale. Regarding claim 13, Tello and Janecek did not explicitly state including multiple message counts and message limits. Applicant is reminded that adding/duplicating parts for multiple effect does not make an invention patentable, see duplicating parts for a multiple effect St. Regis Paper Co. v. Bemis Co., Inc., 193 USPQ 8 (7th Cir. 1977). It would have been obvious for one of ordinary skill in the art at the time the invention was made to have a plurality of

message counts and thresholds in order to properly carry out the function of preventing users from spamming (Tello, col. 6, lines 1-9).

2. Regarding claim 3, Tello and Janacek disclosed the features of the invention, substantially as claimed, as described in claims 2 and 15, including wherein the step of comparing the message count associated with an originator identity of the outbound message includes the steps of.

obtaining an originator address associated with the outbound message (Tello, col. 5, lines 55-67);

obtaining the originator identity associated with the outbound message by performing an originator identity lookup based on the originator address (Tello, col. 5, lines 55-67); and

obtaining at least one message count associated with the originator identity by performing a message count lookup based on the originator identity (Janacek, col. 10, lines 55-67, col. 12, lines 1-5). See above for motivation.

Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tello et al. (U.S. Patent Number 6,381,634) in view of Barchi (U.S. Patent Number 6,507,866).

3. Regarding claims 1-6 12, 14-17, and 26-28, Tello disclosed a system and method for controlling transmission of messages from an originator computer system, comprising:

a processor, memory system, and network interface (Tello, col. 3, line 60 through col. 4, line 5);

detecting an outbound message from an originator computer system;

verifying an authenticity of an originator address associated with the outbound message by comparing a mapping of network addresses with account names such that the originator is associated with a valid account name and network address pair;

performing a quota enforcement operation based on a message count and a message limit to produce a message transmission result; and

performing a selective transmit operation including at least one of

i) transmitting the outbound message onto a computer network if the message transmission result contains a transmit value; and

ii) preventing transmission of the outbound message onto a computer network if the message transmission result contains a no transmit value;

in order to determine a message transmission result that indicates if the originator computer system operating to transmit the outbound electronic mail message using the originator identity is attempting to transmit the outbound electronic mail message to a number of recipients that exceeds the message limit, and if the message transmission result is a no-transmit value, preventing transmission of outbound electronic mail messages onto the computer network for the originator identity, and if the message transmission result is a transmit value, allowing transmission of the outbound electronic mail message onto the computer network on behalf of the originator identity. (Tello, col. 5, lines 45-65, col. 6, lines 9-20, Tello discloses the SCP server

detecting outbound messages from **subscribed users**, and performing a quota enforcement operation by comparing the number of messages sent by a user with a global threshold limit. If the message count exceeds the threshold limit, the messages do not get transmitted, and an error message is returned. In regards to verifying an authenticity of an originator address associated with the outbound message, Tello disclosed password-protected accounts for users to use their unique email addresses. Tello also disclosed that the user's literal IP address is included in this authorization).

However, Tello did not explicitly state when the result is a transmit value, updating a message count associated with the originator identity of the outbound message. In an analogous art, Barchi discloses an email usage pattern detection system that checks whether the number of email messages from a single originator has exceeded predetermined thresholds (Barchi, col. 7, line 65 through col. 8, line 10). Tello and Barchi both include systems that check for sender side email thresholds for the purpose of keeping track of unwanted messages. Therefore, it would have been obvious to one in the ordinary skill in the art at the time of the invention to incorporate Barchi into Tello to provide protection for the receiving email system not only against malicious users, but also against events such as routing accidents (Barchi, col. 5, lines 60-67). See above for motivation.

4. Regarding claims 3 and 16, Tello and Barchi disclosed the features of the invention, substantially as claimed, as described in claims 2 and 15, including wherein

the step of comparing the message count associated with an originator identity of the outbound message includes the steps of.

obtaining an originator address associated with the outbound message (Tello, col. 5, lines 55-67);

obtaining the originator identity associated with the outbound message by performing an originator identity lookup based on the originator address (Tello, col. 5, lines 55-67); and

obtaining at least one message count associated with the originator identity by performing a message count lookup based on the originator identity (Barchi, col. 8, lines 1-8). See above for motivation.

5. Regarding claims 4 and 17, Tello and Barchi disclosed the features of the invention, substantially as claimed, as described in claim 3, including wherein:

the step of obtaining an originator address includes retrieving a network address associated with the outbound message from a message connection establishment protocol used to transfer the outbound message from an originator computer system to a recipient computer system (Barchi, col. 8, lines 1-8);

the step of obtaining the originator identity includes the step of querying a login database containing mappings of originator addresses to originator identities based on the originator address obtained in the step of obtaining an originator address (Tello, col. 5, lines 55-67, Barchi, col. 8, lines 1-8); and the

step of obtaining a message count for the originator identity associated with the outbound message includes querying a quota database containing associations of

message counts to originator identities based on the originator identity associated with the outbound message (col. 8, lines 1-8); and

wherein the message count is at least one message count that indicates, for an originator identity, a current number of outbound message transmitted over an elapsed time interval (Barchi, col. 7, line 65 through col. 8, line 10); and

wherein the message limit is at least one message limit corresponding to a respective at least one message count that indicates, for an originator identity, a maximum number of outbound messages that may be transmitted over a predetermine time interval (Barchi, col. 7, line 65 through col. 8, line 10). See above for motivation.

6. Regarding claims 5 and 18, Tello and Barchi disclosed the features of the invention, substantially as claimed, as described in claims 2 and 15, including wherein the step of updating the message count associated with the originator identity of the outbound message includes the steps of calculating a total number of recipients for the outbound message and incrementing the message count associated with the originator identity by the total number of recipients for the outbound message (Barchi, col. 8, lines 1-45, Barchi discloses tracking recipients of email messages). See above for motivation.

7. Regarding claims 6 and 19, Tello and Barchi disclosed the features of the invention, substantially as claimed, as described in claims 2 and 15, including wherein the message limit indicates an amount of outbound messages that may be transmitted

from the originator computer system over a certain period of time for the originator identity associated with the outbound message (Barchi, col. 8, lines 1-10, Barchi discloses a threshold for a period of time); and

wherein the originator identity of the outbound message is indicative of at least one of:

a specific user account operating under control of a computer user;

a specific message sending user; and

a specific domain (Tello, col. 5, lines 59-67, Barchi, col. 7, line 65 through col. 8, line 8).

8. Regarding claims 7 and 20, Tello and Barchi disclosed the features of the invention, substantially as claimed, as described in claims 2 and 15, including wherein:

the message limit condition indicates if a computer user account associated with the originator identity used to transmit the outbound message is attempting to transmit a number of outbound messages that exceeds the message limit in a predetermined amount of time (Barchi, col. 7, line 65 through col. 8, line 8); and

wherein the message limit condition occurs if the step of comparing determines at least one of the message count exceeds the message limit(Barchi, col. 7, line 65 through col. 8, line 8); and

the message count is equal to the message limit (Barchi, col. 7, line 65 through col. 8, line 8) See above for motivation.

9. Regarding claims 8 and 21, Tello and Barchi disclosed the features of the invention, substantially as claimed, as described in claims 2 and 15, including wherein the quota enforcement operation includes the steps of:

verifying authenticity of at least one recipient associated with outbound message (Tello, col. 3, lines 50-67, Barchi, col. 8, lines 1-50). See above for motivation.

10. Regarding claims 9 and 22, Tello and Barchi disclosed the features of the invention, substantially as claimed, as described in claims 1 and 14, including wherein the step of performing a quota enforcement operation includes the step of:

comparing a previous message transmission result with a no-transmit value, and if the previous message transmission decision equals the no-transmit value, performing the step of performing a selective transmit operation (Barchi, col. 8, lines 1-45). See above for motivation.

11. Regarding claims 10 and 23, Tello and Barchi disclosed the limitation of claims 1 and 14, including wherein the step of detecting an outbound message includes the steps of:

searching a quota enforcement list for an originator address associated with the message, and if the originator address associated with the message is contained in the quota enforcement list, performing the steps of performing a quota enforcement operation and performing a selective transmit operation, and if the originator address associated with the message is not contained in the quota enforcement list, skipping the step of performing the quota enforcement operation and performing the step of

transmitting the outbound message from the computer system (Barchi, col. 8, lines 1-45). See above for motivation.

12. Regarding claims 11 and 24, Tello and Barchi disclosed the features of the invention, substantially as claimed, as described in claim 1, including the steps of:

authenticating a connection from the originator computer system (Tello, col. 5, lines 55-67);

recording authentication information in a login database, the authentication information including an originator address assigned to the originator computer system and an originator identity associated with the originator address (Tello, col. 5, lines 55-67);

receiving, for transmission to a recipient computer system, the outbound message from the originator computer system (Tello, col. 5, lines 55-67, col. 6, lines 1-20);

forwarding the outbound message to a quota server to perform the steps of detecting an outbound message, performing a quota enforcement operation and performing a selective transmit operation (Tello, col. 5, lines 55-67, col. 6, lines 1-20). See above for motivation.

13. Regarding claim 13, Tello and Barchi disclosed the features of the invention, substantially as claimed, as described in claim 12, including wherein:

the at least one message count includes a first message count and a second message count (Barchi, col. 8, lines 1-45);

wherein the at least one message limit includes a first message limit and a second message limit(Barchi, col. 8, lines 1-45);

wherein in the step of comparing, the first message count is compared to the first message limit to determine if the first message count exceeds the first message limit in which case the message transmission result is set to a no-transmit value (Barchi, col. 8, lines 1-45); and

wherein in the step of comparing, the second message count is compared to the second message limit to determine if the second message count exceeds the second message limit in which case the message transmission result is set to a no-transmit value (Barchi, col. 8, lines 1-45).

14. Regarding claim 25, Tello and Barchi disclosed the features of the invention, substantially as claimed, as described in claim 24, including wherein the port redirector is a data communications device capable of directing outbound messages based on content contained within the outbound message, and wherein when the port redirector receives an outbound message that is to be subject to message quota enforcement based upon content contained with the outbound message,, the port redirector forwards the outbound message to the quota server (Tello, col. 5, lines 20-45). See above for motivation.

Response to Amendment

Applicant's arguments and amendments filed on 6/16/2006 have been carefully considered but they are not deemed fully persuasive.

Applicant's arguments include the failure of previously applied art to expressly disclose the teachings "verifying the authenticity of an originator address associated with an outbound message [see Applicant's Response, page15, paragraphs 4, 5, and 6].

Examiner respectfully disagrees. Examiner has already addressed this argument in the Examiner's Answer submitted 5 May 2006.

It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part

of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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